UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/527,909 | 03/14/2005 | Tomoaki Endoh | 03500.017742. | 9057 |

5514 7590 11/26/2008

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

| EXAMINER | |
|---|---|
| JOHNS, CHRISTOPHER C | |
| ART UNIT | PAPER NUMBER |
| 3621 | |
| MAIL DATE | DELIVERY MODE |
| 11/26/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/527,909 | ENDOH, TOMOAKI | |
| | Examiner | Art Unit | |
| | Christopher C. Johns | 3621 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *02 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-13 and 32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/28/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Acknowledgements*

1. Claims 14-31 and 33 have been cancelled.

2. Claims 1-13 and 32 are pending.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 7-12 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

5. Based on Supreme Court precedent[1] and recent Federal Circuit decisions, a §101 process must (1) be tied to a machine (e.g. a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.[2] If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. §101.

6. In this particular case, the method in claim 7 is not tied to a particular machine - while it recites an "image forming apparatus", it is not directly tied to the apparatus. Rather, it is tied to a "program…or a function" executable on an image forming apparatus. There is also no transformation recited in the claim.

---

[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

[2] The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972). Also see *In re Bilski* (2008).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-13 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent 7,222,104 ("Tadayon") in view of Microsoft Windows Installer (as taught by "Error Message - Another version is already installed - Can't Install", a posting to the microsoft.public.office.setup Usenet group from 26 January 2002, hereafter "Microsoft").

9. As per claims 1, 7, 13, and 31, Tadayon discloses:

10. acquisition means for acquiring (figure 1, reference number 150), via a network (column 6, lines 27-34 - "For example, tags can be used for identification and referral to a specific server for edge delivery of content on the Internet"), license identification information identifying license information, and license information (figure 2, reference numbers 212, 214, 312);

11. management means for managing license identification information (figure 1, reference numbers 120, 150; figure 2, reference number 250, 252; column 4, lines 35-38 – "clearinghouse also maintains various records regarding ownership and usage rights…");

12. Tadayon may not explicitly disclose:

13. determination means for determining whether the acquired license identification information corresponding to the acquired license information is included in the license

identification information managed by management means so as to avoid a duplicate installation of the license information;

14. installation means for, if the determination means determines that the acquired license information corresponding to the acquired license information is not included in a license identification information managed by the management means, installing the license information to add the amount of allowed usage of the program in accordance with the license information acquired;

15. wherein the installation means does not install the license information if the determination means determines that the acquired license identification information corresponding to the acquired license information is included in the license identification information managed by the management means.

16. The idea of preventing a install of software/data that is already installed was well-known to those skilled in the art at the time of the invention, as a simple method of preventing wasted space and wasted time (as if a piece of software is already installed and working properly, there is no reason to install it again). The Examiner holds that if not inherent in the art of computer software, it would be painfully obvious to a person having ordinary skill in the art to do so.

17. In any case, Microsoft teaches a feature that prevents the reinstallation of software ("Another version of this product is already installed. Installation of this version cannot continue.") This is done to prevent unnecessary reinstallation of programs - as the program is already installed, there is no reason to reinstall the program. Microsoft teaches:

18. making a determination as to whether the software is already installed (instant application: "determining whether the acquired license…is included in the…information

managed by the management means so as to avoid a duplicate installation of the license information");

19. if the software were not installed, the program would install (instant application: "determines that the…information is not included in the license identification information managed by the management means");

20. finally, if the software is installed, the program will not install (instant application: "does not install the license information if…the license information is included in the…information managed by the management means").

21. This saves on time and disk space, as installing software/data a second time would result in wasted time and a higher usage of hard disk space.

22. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tadayon to check if data has been installed or is otherwise currently on the system, as it would result in less disk space usage and a more efficient system. A person having ordinary skill in the art would see this as advantageous because of its efficiency and speed.

23. As per claims 2 and 8, Tadayon discloses as above, and further discloses:

24. managing expiration-date-of-installation information indicating a period during which the license information acquired by the acquisition means is valid (column 6, lines 19-25 - "user may have the right to use content for a specific time period");

25. authenticating expiration date of installation of the license information (as the time data is part of the license data, and the licenses are inherently authenticated, the expiration date is inherently authenticated at the same time).

26. As per claims 3 and 9, Tadayon discloses as above, and further discloses:

27. managing an encryption key (column 4, lines 9-19 - "private key corresponding to user…two users and two digital works in the preferred embodiment") of an already-installed program code together with program identification information identifying the program (it is inherently necessary to manage the program by having a way to refer to the program, because is necessary to point to the proper program in order to manage it - furthermore, in the "preferred embodiment" in column 4, line 18, the users have their own devices and their own keys, which means that the devices have their own keys. As the devices inherently contain programs (in order to operate properly), these programs and keys are in a 1-to-1 ratio and are therefore "identifying").

28. As per claims 4 and 10, Tadayon teaches as above, and further teaches:

29. license information encrypted using an encryption key uniquely assigned to the image forming apparatus, decrypting the encrypted license information (it was well-known to those skilled in the art at the time of the invention to have "device keys" - furthermore, in the "preferred embodiment" in column 4, line 18, the users have their own devices and their own keys, which means that the devices have their own keys. As the devices are inherently used by users, the users, keys, and apparatuses are in a 1-to-1-to-1 ratio, the keys are therefore "assigned" to the image forming apparatus).

30. As per claims 5 and 11, Tadayon discloses as above, and further discloses:

31. increasing an already-installed right of usage of the program if the license information indicates an increment in the right of usage, decreasing if the license information indicates an decrement in the right of usage (column 6, lines 5-18 - "user buys a license…can transfer the usage rights to user 132 in a manner similar to [the normal manner]". Should the second user already have rights to the file, those usage rights will be overwritten by the new rights - e.g.: if the new rights are fewer, the rights to the file will be decreased).

32. As per claims 6 and 12, Tadayon discloses as above, and further discloses:

33. managing the license information in the form of certification information, license information certifies the right of usage of a program (the inherent purpose of licenses is to provide certification of usability, also see column 2, line 62 - column 3, line 9 - "usage rights are encapsulated with the content…can permit various types of use such as viewing only, use once, distribution, and the like").

34. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tadayon, in view of Microsoft, further in view of Official Notice.

35. As per claims 4 and 10, it is the examiner's primary position that the claims are anticipated because of the above inherent features (i.e. keys tied to a particular device). However, if not inherent, then the Examiner takes Official Notice that the idea of "device keys" was old and well-known in the art because it allows for a device-centric method of encrypting data, which does not depend upon user keys to be entered. Device keys have been used in countless Digital Rights Management systems, and are known to be advantageous because they

allow for a stronger system - if a device is known to act in a way that the content owners do not desire, the solution is to no longer issue content tied to that device. The prior art is replete with this idea (see, for example, United States Patent Application Publication 2002/0007456, paragraph 312 - "To constitute the code image 78, and in one embodiment of the present invention, there is a manufacturer-specific device key KMAN which is unique to each portable device 62 but independent of the CPU key 66. The purpose of KMAN is to allow each device manufacturer to administrate its device secrets independently.")

36. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Tadayon the idea of a "device key", since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable. Furthermore, a person having ordinary skill in the art would see this as advantageous because it allows for a more secure system - if a device is found to be non-compliant, a content creator merely has to cease issuing content tied to that device, and the chain of data security remains intact.

### *Response to Arguments*

37. Applicant's arguments with respect to claims 1-13 and 32 have been considered but are moot in view of the new ground of rejection. They appear to argue limitations that were not previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

38. Furthermore, in response to Applicant's arguments concerning the improperness and "premature" nature of the Double Patenting rejection, the Examiner vehemently disagrees.

39. MPEP §804 notes that "Before consideration can be given to the issue of double patenting, two or more patents or **applications** must have at least one common inventor and/or be either commonly assigned/owned…". The MPEP, case law, and statutes are clear - if two pending applications claim the same invention, a double patenting rejection ***is*** proper.

40. MPEP §804(I)(B) deals exactly with this situation - "[w]here this issue can be addressed without violating the confidential status of applications (35 U.S.C. 122), the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting"[3].

41. Finally, such rejections should be maintained: MPEP §804(I)(B) further notes that "The 'provisional' double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications". However, the Examiner has not made the rejection at this time because the claims in the copending application, 10/683293, are ***no longer*** an issue of double patenting.

42. As per Applicant's arguments concerning the Official Notices, Applicant's attempt at traversing the Official Notice findings as stated in the previous Office Action (Paper No. 20080512, Paragraph No. 15) is inadequate. Adequate traversal is a two step process. First, Applicant must state their traversal on the record. Second, and in accordance with 37 C.F.R.

[3] The Manual goes on to cite important precedent: *In re Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976);

§1.111(b), which requires Applicants to specifically point out the supposed errors in the Office Action, Applicants must state why the Official Notice statements are not to be considered common knowledge or well known in the art.

43. In this application, while Applicant has clearly met step (1), Applicant has failed step (2) since they have failed to argue why the Official Notice statements are not to be considered common knowledge or well known in the art. Because Applicant's traversal is inadequate, the Official Notice statements are taken to be admitted as prior art. See MPEP §2144.03.

***Conclusion***

44. **Examiner's Note:** Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. Furthermore, it must be noted that the documents cited on any enclosed PTO-892 or PTO-1449 form are cited in their entirety.

45. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

---

*In re Wetterau*, 356 F.2d 556, 148 USPQ 499 (CCPA 1966).

46. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

47. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

48. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

49. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher C Johns
Examiner
Art Unit 3621

CCJ

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685